REMARKS

Reconsideration and allowance of the subject application are respectfully requested. Claims 1-10 are all the claims pending in the application. In response to the Office Action, Applicant respectfully submits that the claims define patentable subject matter.

I. Overview of the Office Action

Claims 3, 5, and 9 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Claims 1, 3, 5, and 9 are rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Claims 1-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over previously cited Ejzak (U.S. Patent No. 6,954,654) in view of newly cited Hsu et al. (U.S. Patent Application Publication No. 2004/0010473, hereafter, "Hsu") and newly cited Landherr et al. (U.S. Patent No. 6,880156, hereafter "Landherr"). Applicant respectfully traverses the prior art rejections.

II. Rejections Under 35 U.S.C. § 112

The Examiner has rejected claims 3, 5, and 9 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. By this Amendment, Applicant has amended claims 3, 5, and 9 in order to change the term "adapted" to "configured". Accordingly, the Examiner is requested to withdraw the § 112 second paragraph, rejection. Accordingly, the Examiner is requested to withdraw the § 112 rejection.

III. Rejection Under 35 U.S.C. § 101

The Examiner has rejected claims 1, 3, 5, and 9 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Specifically, the Examiner asserts that the claims fail to achieve a tangible result. Applicant respectfully disagrees with the Examiner's position.

MPEP 2106.IV.C(2) details the review that should be made to determine whether a claimed invention falls within 35 U.S.C. § 101 judicial exceptions, since claims directed to nothing more than abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature are not eligible for patent protection. MPEP 2106.IV.C further states that while abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be.

MPEP 2106.IV.C.2 then outlines the various evaluations that must be made to determine whether a claimed invention covers either a 35 U.S.C. § 101 judicial exception (abstract ideas, natural phenomena, and laws of nature) or a practical application of a 35 U.S.C. § 101 judicial exception. One of these evaluations includes determining whether the practical application produces a useful, concrete and tangible result, wherein the tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a 35 U.S.C. § 101 judicial exception, in that the process claim must set forth a practical application of that judicial exception to produce a real-world result."[2]

[2] MPEP 2106.IV.C(2)(b).

The instant application does not pertain to an abstract idea (such as mathematical algorithms), a natural phenomenon, or laws of nature.

MPEP 2106 further states that if USPTO personnel determine that the claim does not entail the transformation of an article, then USPTO personnel shall review the claim to determine if it produces a useful, tangible, and concrete result. In making this determination, the focus is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather on whether the final result achieved by the claimed invention is "useful, tangible, and concrete.

In independent claim 1 and analogous independent claims 3, 5, and 9, a method for selecting an Application Server is presented. Upon analysis of an incoming IP multimedia call by a primary application server, the call is presented to a called party terminal along with a set of service applications for answering the incoming call. A call session network element receives a selection of at least one service application from the set of service applications and uses that selected service application to answer the incoming call. The answering of the incoming call with the selected service application would be the tangible result of the invention as claimed in claim 1 and analogously claimed in claims 3, 5, and 9. Accordingly, Applicant respectfully submits that the claims clearly achieve a tangible result, and requests that the Examiner withdraw the § 101 rejection.

IV. Rejections Under 35 U.S.C. § 103

The Examiner appears to assert that Ejzak teaches all of the elements of independent claim 1 and analogous independent claims 3, 5, and 9 except for an IP protocol, activating an application server, and the element of selecting at least one service application from the set of

service applications. The Examiner thus relies on Hsu and Landherr to allegedly remedy these conceded deficiencies. Applicant respectfully disagrees with the Examiner.

First, Applicant respectfully submits that there is no teaching or suggestion in Ejzak that "said primary application server (AS_{Prim}), upon analysis of said incoming IP multimedia call presenting said incoming IP multimedia call to said called party terminal (CDPT) together with a set of service applications for answering said incoming call, said set of service applications being determined in said analysis", as recited in claim 1 and analogously recited in claims 3, 5, and 9.

The Examiner cites column 13, lines 11-18 of Ejzak as allegedly teaching this aspect of the claims. However, this cited portion of Ejzak merely teaches that when a user equipment is registered, subscriber profile information is sent to the serving Call State Control Function (S-CSCF). The S-CSCF then provides all features and services for the registered user equipment. Ejzak does not teach or suggest that, after analyzing an incoming IP multimedia call, the S-CSCF presents the call to the called party together with a set of service applications for answering the incoming call, as claimed.

In Ejzak, the S-CSCF "provides all features and services for the user equipment". Therefore, there is no need for the S-CSCF to provide service applications to the user or the user equipment. Ejzak teaches that when a mobile unit initiates a call to a PSTN address, the S-CSCF queries a Domain Name System (DNS) to determine now to proceed with the call initiation (see column 8, lines 58-65). The DNS then provides attributes associated with the PSTN service. Nowhere does Ejzak teach or suggest that "said primary application server (AS_{Prim}), upon analysis of said incoming IP multimedia call presenting said incoming IP multimedia call to said called party terminal (CDPT) together with a set of service applications for answering said

incoming call, said set of service applications being determined in said analysis", as recited in claim 1 and analogously recited in claims 3, 5, and 9.

As discussed above, the Examiner acknowledges that Ejzak does not teach or suggest activating an application server. The Examiner thus relies on Landherr to cure this deficiency. However, Applicant respectfully submits that the claims cannot be evaluated in a fragmented manner.

Claim 1 and analogous claims 3, 5, and 9 recite "said call session control Network element (CSCF) upon intercepting said incoming IP multimedia call activating a dedicated primary application server". Applicant agrees that Ejzak does not teach or suggest this element of the claims. Further, Applicant respectfully submits that Landherr has little or no relevance to the claimed invention. Landherr teaches a method for activating spare servers connected to a computer network. A load detector is connected to one or more server applications and the computer network, and an allocator is connected to the load detector and the server applications. The allocator causes the server application to activate in response to a load condition (see column 2, lines 13-22). Nowhere does Landherr teach or suggest that a "call session control Network element (CSCF) upon intercepting said incoming IP multimedia call activating a dedicated primary application server", as recited in the claims. The Landherr system activates an additional server application on the server based on the load on the server. Landherr does not activate a dedicated primary application server upon intercepting an incoming IP multimedia call, as required by the claims.

The Examiner also acknowledges that Ejzak does not teach or suggest "said call session control Network element (CSCF) receiving a selection of at least one service application from said set of service applications forwarded by said called party terminal", as recited in the claims.

The Examiner thus cites paragraph [0041] of Hsu as allegedly teaching this aspect of the claims. Applicant respectfully disagrees with the Examiner and further submits that Hsu has no relevance to the claimed invention.

Hsu merely teaches a rule-based packet selection, storage, and access system for processing packets from network traffic. Packets intercepted from network traffic are selected based on at least one rule. The selected packets are stored in an in-kernel storage buffer, and an access mechanism is provided to a packet usage application for accessing the stored packets (the Abstract). Each packet is divided into plural fields whose function is defined by a predetermined protocol, and the rules can compare one or more fields in an incoming packet with predetermined values and select that packet for logging. Applicant respectfully submits that this has no relevance to the claimed invention.

Accordingly, applicant respectfully submits that independent claim 1, 3, 5, and 9 should be allowable because the cited reference does not teach or suggest all of the features of the claims. Claims 2, 4, 6-8, and 10 should also be allowable at least by virtue of their dependency on independent claims 1, 3, 5, and 9.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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